



#23
W. Layman
12/30/03
PATENT 1003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)

Theodore D. Wugofski et al.)

Serial No.: 09/002906)

Filed: January 05, 1998)

For: A SYSTEM FOR
MANAGING FAVORITE
CHANNELS)

Examiner: Hai Tran

Group Art Unit: 2611

Docket: 450.196US1

RECEIVED

DEC 22 2003

Technology Center 2000

APPELLANTS' BRIEF ON APPEAL

Mail Stop Appeal Brief
Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is presented in support of the Notice of Appeal filed on October 14, 2003, from the final rejection of claims 1-12 and 19-29 of the above-identified application, as set forth in the Final Office Action mailed August 13, 2003.

The Appeal Brief is filed in triplicate. Please charge the requisite fee of \$330.00 set forth in 37 C.F.R. § 1.17(c) to Deposit Account 50-0439. Please charge any required additional fees or credit overpayment to Deposit Account 50-0439.

12/22/2003 MDAMTE1 00000025 190743 09002906

01 FC:1402 330.00 DA

RECEIVED

DEC 22 2003

Technology Center 2600

APPELLANTS' BRIEF ON APPEAL

TABLE OF CONTENTS

	<u>Page</u>
1. REAL PARTY IN INTEREST	2
2. RELATED APPEALS AND INTERFERENCES.....	2
3. STATUS OF THE CLAIMS.....	2
4. STATUS OF AMENDMENTS	2
5. SUMMARY OF THE INVENTION	2
6. ISSUES PRESENTED FOR REVIEW	3
7. GROUPING OF CLAIMS	3
8. ARGUMENT	4
9. SUMMARY	10
APPENDIX I-The Claims on Appeal	11

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, AMIGA DEVELOPMENT LLC., by virtue of an Assignment recorded in the U.S. Patent and Trademark Office on January 5, 1998, at Reel 8927, Frames 0907-0910. AMIGA DEVELOPMENT LLC is a wholly owned subsidiary of Gateway Inc.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in the present appeal.

3. STATUS OF THE CLAIMS

Claims 1-12 and 19-29 are pending in the application and have all been finally rejected. The rejected claims 1-12 and 19-29 are the subject of the present appeal.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action mailed to the Appellants on August 13, 2003.

5. SUMMARY OF THE INVENTION

A computerized system (FIG. 2) manages favorite channels (FIG. 5) based on a user specified theme (p11, l 4- p12, l 14, FIG.s 6A, 6B and 6C). Favorite channel lists (FIG. 5 p8, l 12-21) contain logical channels (p8, l 1-10) relating to the user specified theme. The system identifies the logical channels showing an event of the user specified theme and automatically adds each of the logical channels to the favorite channel list (p8, l 12-21, p11, l 5-9) without user intervention. A favorites database (p10, l 18- p11, l 3) stores the favorite channel lists.

An electronic program guide (EPG) content database (14 p7, l 12) stores a plurality of events available on one or more channels for a period of time. The user specified theme (p11, l 5-9) corresponds to a theme field (p11, l 15-25) of the events in the EPG content database. An

EPG data service manages the EPG content database and provides functions (p 8, l 23- p9, l 9) for loading electronic program guide-type data from one or more data services.

Interfaces and a plurality of management functions may be provided for each one of the favorite channel lists (p 8, lines 12-21). Management functions may include adding a favorite event to one of the favorite channel lists, removing a favorite event from one of the favorite channel lists, and selecting a favorite event from one of the favorite channel lists. A channel map service (FIG. 3) is provided for determining a physical channel number and a corresponding physical device for each one of the logical channels.

Channels are identified in one embodiment by matching one or more event themes from the electronic program guide content database to the user-specified theme, and automatically adding each one of the channels to the favorite channel list (p 11, l5- p12, l 14). One or more event sub-themes or generic event sub-themes (p11, l 19-25) from the electronic program guide content database may be matched to the user-specified theme. The logical channels identified may depend on an update frequency of the electronic program guide content database and a number of time slots included in the favorite channels list. One or more words in a event description from the EPG content database may also be matched to the user-specified theme.

A computer (110, page 5) may also be programmed to perform the above functions.

6. ISSUES PRESENTED FOR REVIEW

Whether claims 1-12 and 12-29 are patentable over Schein (US 6002394) in view of Kostreski et al (US 5734589).

7. GROUPING OF CLAIMS

Claims 1-12, 19, 23-24 and 29 are grouped together for purposes of appeal and are argued separately.

Claims 20, 21, 26, and 27 are grouped together for purposes of appeal and are argued separately at least on the basis of the use of sub-themes.

Claims 22 and 28 are grouped together for purposes of appeal and are argued separately at least on the basis of identifying channels based on an update frequency of the EPG content database and a number of time slots included in the favorite channels list

8. ARGUMENT

I) Rejections under 35 U.S.C. § 103

a) The Applicable Law

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988).

In combining prior art references to construct a *prima facie* case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.*

The M.P.E.P. contains explicit direction to the Examiner that agrees with the court in *In re Fine*:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d (BNA) 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re*

Nilssen, 851 F.2d 1401, 1403, 7 U.S.P.Q.2d (BNA) 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 U.S.P.Q. (BNA) 171, 174 (C.C.P.A. 1979)). However, the level of skill is not that of the person who is an innovator but rather that of the person who follows the conventional wisdom in the art. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 474, 227 U.S.P.Q. (BNA) 293, 298 (Fed. Cir. 1985).

The Federal Circuit, in the recently decided *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), reiterated the prior cases and specifically required that

“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching motivation or suggestion to select and combine the references relied on as evidence of obviousness” 61 USPQ2d at 1433.

The Federal Circuit in *In re Lee* also indicated that the “factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.” 61 USPQ2d at 1434.

The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985). The Examiner can only rely on references which are either in the same field as that of the invention, or if not in the same field, must be “reasonably pertinent to the particular problem with which the inventor was concerned.” *M.P.E.P.* § 2141.01 (a) (citing *In re Oetiker*, 24 U.S.P.Q.2d (BNA) 1443 at 1445). The Examiner must also recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d (BNA) 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990). Furthermore, if the proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *M.P.E.P.* § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Finally, the Examiner must avoid hindsight. *Id.* The Examiner cannot use the Applicant's structure as a "template" and simply select elements from the references to reconstruct the

claimed invention. *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991).

b) Discussion of the Rejection

Claims 1-12 and 19-29 were rejected under 35 USC § 103(a) as being unpatentable over Schein et al. (US 6,002,394) in view of Kostreski et al. (US 5,734,589). This rejection is respectfully traversed.

The Office Action of August 8, 2003, in the “Response to Arguments” indicates that Schein et al. “identifies the channels/programs showing an event of the user specified theme (criteria) and automatically adds each of channels/programs to the favorite channel list without user intervention (Co. 16, lines 25-35)” This assertion of the teaching of Schein is respectfully traversed. Schein et al. does not identify “channels”. Schein et al. appears to identify programs, not channels at the language cited:

“When the viewer selects a **program** as a favorite, for example, he or she will have the option of designating the criteria or reasons(s) that the **program** is a favorite (i.e., actor, director, etc.). The computer will include a processor and suitable software for automatically searching the database for other **programs** having the same criteria. The processor will automatically place the programs that include the designated criteria into the selection window and provide visual indication of each **program** in the matrix of cells in the **program** guide. In this way, the program guide will automatically customize itself to the individual viewer to facilitate use of the television schedule.” Emphasis added.

This appears to be nothing more than just a search for programs that might be similar to a selected favorite program. It has nothing to do with creating and managing a favorite channel list. Schein et al. clearly provides visual indications of programs, not favorite channels. The Office Action also cites Col. 10, lines 55-60 of Schein et al. as disclosing favorite channel lists. The section in Col. 10, with the heading of “FAVORITE CHANNEL LISTS” clearly sets forth that “The user interface and database engine provide screens to facilitate the ordering and

selection of channels to be displayed in the guide” at lines 47-49. There is no teaching of any sort of automated adding of channels without user intervention as claimed. If anything, the cited language teaches away from the claimed invention, as a user interface is used and appears to directly require user interaction for selection of channels. It should be noted that this language is also consistent with the background of the invention section of the present application, where the user management of favorite channel lists was identified, as was the problem they created of having favorites lists “only as organized as the user who created them.”

Thus, the Office Action appears not to be considering the teaching of the Schein et al. as a whole. When doing so, there is no automated management of a favorite channel list as claimed. Kostreski et al. is cited as teaching mapping favorite channel lists to corresponding logical or virtual channels. This assertion is respectfully traversed. While some aspects of mapping appear, there is no mention of any type of favorite channel found in Kostreski et al. Even if there were, Kostreski et al. still lacks the teaching indicated above as missing from Schein et al. Thus neither Schein nor Kostreski nor their combination teach each and every element of Applicant’s claims 1, 8, 19, 24 and 25. Applicant respectfully requests the withdrawal of the rejection of claims 1, 8, 19, 24 and 25 as well as the claims that depend therefrom.

The recitation of the obviousness rejections starting on page 4 of the Office Action indicates that Shein et al., manages favorite channels based on a user specified theme as indicated at Col 10, line 40 to Col. 11, line 45. This assertion is respectfully traversed. As previously indicated, channels in a favorite channel list are organized via a user interface. There is no discussion of adding logical channels without user intervention. Further, the rest of the language cited in Shein et al. refers to identification of programs based on theme data structures and theme search. The resulting show list is a list of the programs. It is not a list of favorite channels as claimed.

Throughout the Office Action, channel and program appear to be deemed the same thing. Clearly they are not the same thing. A channel has multiple temporally arranged programs. A program is a single program with an associated channel. There is no way to effectively surf channels via a list of programs because the programs might not be on at the same time. Selection of a program does not necessarily cause current selection of a channel because the program may

not be available at the time it is selected. However, one can move easily from channel to channel in a list of favorite channels. Thus, they are fundamentally different things, and cannot be equated as the Examiner appears to be doing.

Official notice is taken in the office action regarding updating a relational database such as adding or removing a specific record. This notice is respectfully traversed, especially when taken in conjunction with “removing a favorite event from one of the favorite channel lists so that the user could update the favorite according to their choice.” as indicated in the Office Action. The Office Action seems to be stating that an event is indicated as being on a favorite channel list, and apparently is being equated to a channel. Applicant respectfully submits that an event is not a channel, and cannot be so equated.

Claims 2-7, 9-12, 20-23 and 26-29 depend from base claims 1, 8, 19 and 25 respectively. They are therefore non-obvious for the reasons discussed above with respect to their base claims, in addition to adding further patentable distinctions. Applicant respectfully requests the withdrawal of the rejection of claims 2-7, 9-12, 20-23 and 26-29.

Claims 20, 21, 26 and 27 each recite the use of a sub-theme to identify channels to add to the favorites list. Applicant can find no teaching or disclosure of a sub-theme used to identify favorite channels in either Schein or Kostreski. Applicant respectfully requests the withdrawal of the rejection of claims 20, 21, 26 and 27.

Claims 22 and 28 recite that “the logical channels identified during the step of identifying depend on an update frequency of the EPG content database and a number of time slots included in the favorite channels list”. The Office Action rejects claims 22 and 28 by referring to the analysis of claim 2. However, claim 2 does not recite an update frequency nor does claim 2 refer to the number of time slots in the favorite channel list. Therefore, the analysis of claim 2 in the Office Action does not apply to claims 22 and 28, and no prima facie case of obviousness has been established, as each and every element of the claims has not been taught or shown in the references, nor by their combination. Additionally, Applicant has reviewed Schein and Kostreski and can find no teaching or disclosure of the recited language. Applicant respectfully requests the withdrawal of the rejection of claims 22 and 28.

The Office Action indicates that “Schein’s EPG content is inherently updated periodically by the headend in which the favorite channel list depends on the newly updated EPG data. In doing so, the logical channel of the updated favorite channel list has to be re-mapped to corresponding updated logical (virtual) channels.” Applicant respectfully disagrees. The Office Action has not established a *prima facie* case of inherency because, as recited in MPEP § 2112, “In relying upon the theory of inherency, the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” citing Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Office Action only stated that the content is updated periodically. No argument is provided as to why this allegedly inherent characteristic necessarily flows from the teachings of the applied art. Thus, the Office Action does not even assert that the allegedly inherent characteristic is necessary, let alone provide a basis in fact and/or technical reasoning. Applicant respectfully submits that the features of claims 22 and 28: “the logical channels identified during the step of identifying depend on an update frequency of the EPG content database and a number of time slots included in the favorite channels list” does not necessarily flow from the teaching of Schein. Further, the rejection mentions nothing of “a number of time slots” as claimed.

9. SUMMARY

Appellant respectfully submits that the art cited does not render the claimed invention obvious and that therefore the claimed invention does patentably distinguish over the cited art. It is respectfully submitted that claims 1-12 and 19-29 should therefore be allowed. Reversal of the Examiner's rejections of claims 1-12 and 19-29 is respectfully requested. Should the Board be of the opinion that a rejected claim may be allowable in amended form, an explicit statement to that effect is also respectfully requested.

Respectfully submitted,

THEODORE D. WUGOFSKI et al.


By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

Date 12-15-2003

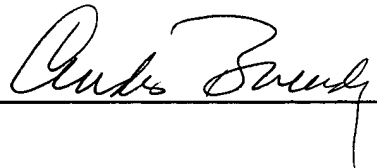
By 
Bradley A. Forrest
Reg. No. 30,837

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Appeal Brief, Commissioner of Patents, P.O.Box 1450, Alexandria, VA 22313-1450, on this 15th day of December, 2003 (Monday).

Candis B. Buending

Name

Signature



APPENDIX I

The Claims on Appeal

1. (Previously presented) A computerized system for managing favorite channels based on a user specified theme, the computerized system comprising:

one or more favorite channel lists, the favorite channel lists comprising one or more logical channels relating to the user specified theme, wherein the computerized system identifies the logical channels showing an event of the user specified theme and automatically adds each of the logical channels to the favorite channel list without user intervention; and
a favorites database for storing one or more favorite channel lists.

2. (Original) The computerized system of claim 1, further comprising an EPG content database storing a plurality of events available on one or more channels for a period of time.

3. (Original) The computerized system claim 2, wherein the user specified theme corresponds to a theme field of the events in an electronic program guide (EPG) content database.

4. (Original) The computerized system of claim 3, further comprising an EPG data service for managing the EPG content database, the EPG data service providing functions for loading electronic program guide-type data from one or more data services.

5. (Original) The computerized system of claim 1, further comprising a favorites service providing one or more user interfaces and a plurality of management functions for each one of the favorite channel lists.

6. (Original) The computerized system of claim 5, wherein the management functions include at least one function selected from the group of functions consisting of: adding a favorite

event to one of the favorite channel lists, removing a favorite event from one of the favorite channel lists, and selecting a favorite event from one of the favorite channel lists.

7. (Original) The computerized system of claim 1, further comprising a channel map service for determining a physical channel number and a corresponding physical device for each one of the logical channels.

8. (Previously presented) A computerized system for managing favorite channels comprising:

- one or more favorite channel lists, the favorite channel lists comprising one or more logical channels relating to a user specified theme, wherein the computerized system identifies the logical channels showing an event of the user specified theme and automatically adds such logical channels to the favorite channel list without user intervention;

- application user interfaces to allow a user to access the computerized system;

- channel map services to map a logical channel number in the favorite channel list to a physical channel number on a physical device available to the computerized system;

- favorites services providing user interfaces and management functions for each one of the favorite channel lists; and

- electronic program guide content services to determine what is programmed on the logical channel and to call channel map services to determine the corresponding physical channel and physical device.

9. (Original) The computerized system of claim 8, further comprising a channel map database for storing an association between each one of the logical channels and a physical channel and a corresponding physical device.

10. (Original) The computerized system of claim 8, wherein the management functions of the favorites service include at least one function selected from the group of functions consisting of: adding one of the logical channels to one of the favorite channel lists, removing one of the

logical channels from one of the favorite channel lists, and selecting one of the logical channels from one of the favorite channel lists.

11. (Original) The computerized system of claim 8, further comprising a favorites database for storing one or more favorite channel lists.

12. (Original) The computerized system of claim 8, further comprising an electronic program guide content database for storing events available on the one or more channels for a period of time.

13-18. (Cancelled)

19. (Previously presented) A method of using a computerized system to dynamically manage favorite channel lists relating to a user specified theme, the method comprising the steps of:

identifying one or more channels showing an event of a user specified theme, wherein the step of identifying is achieved by matching one or more event themes from an electronic program guide (EPG) content database to the user-specified theme, and

automatically adding each one of the channels to a favorite channel list, wherein such adding does not require user intervention.

20. (Original) The method of claim 19, wherein the step of identifying is achieved by matching one or more event sub-themes from an EPG content database to the user-specified theme.

21. (Original) The method of claim 19, wherein the step of identifying is achieved by matching one or more generic event sub-themes from an EPG content database to the user-specified theme.

22. (Original) The method of claim 19, wherein the logical channels identified during the step

of identifying depend on an update frequency of the EPG content database and a number of time slots included in the favorite channels list.

23. (Original) The method of claim 19, wherein the step of identifying is achieved by matching one or more words in a event description from the EPG content database to the user-specified theme.

24. (Previously presented) A computer comprising:
a processor;
a computer-readable medium; and
a plurality of computer instructions executed from the computer readable medium by the processor for performing the steps of identifying one or more channels showing an event of a user specified theme and automatically adding each one of the channels to a favorite channel list without user intervention.

25. (Previously presented) A computer readable medium having computer executable instructions stored thereon for execution on a computer, the computer executable instructions comprising:

identifying one or more channels showing an event of a user specified theme, wherein identifying is achieved by matching one or more event themes from an electronic program guide (EPG) content database to the user-specified theme ; and

automatically adding each one of the channels to a favorite channel list, wherein such adding does not require user intervention.

26. (Original) The computer readable medium of claim 25, wherein identifying is achieved by matching one or more event sub-themes from an EPG content database to the user-specified theme.

27. (Original) The computer readable medium of claim 25, wherein identifying is achieved by

matching one or more generic event sub-themes from an EPG content database to the user-specified theme.

28. (Original) The computer readable medium of claim 25, wherein the channels identified during the step of identifying depend on an update frequency of the EPG content database and a number of time slots included in the favorite channels list.

29. (Previously presented) The computer readable medium of claim 25, wherein identifying is achieved by matching one or more words in an event description from the EPG content database to the user-specified theme.